

Application No. 09/833,151
Attorney Docket No. 00/8026
Customer No. 32,127

REMARKS

This Amendment supplements the Reply to Office Action filed in response to the Office Action ("OA") mailed June 16, 2004. The Examiner is requested to enter this Supplemental Amendment, to disregard the Remarks filed October 18, 2004, and to consider the remarks presented below.

Claims 1-37 were presented for examination and were rejected. Claims 1, 6, 9, 16-19, 22, and 35 have been amended. Claims 12-15 are canceled. No claims are added. Thus claims 1-11 and 16-37 are pending. Claims 1, 6, 9, 16, 19, 22, 31 and 35 are independent claims.

In the Office Action the Examiner objected to claim 35. The Examiner also rejected the following claims under 35 U.S.C. § 103(a): claims 1-3, 5, 22-26, and 35-37 as unpatentable over U.S. Patent No. 6,034,621 to Kaufman in view of U.S. Publication No. US 2003/0023759 to Littleton et al.; claim 4 as unpatentable over Kaufman in view of Littleton, and further in view of U.S. Patent No. 6,643,669 to Novak et al.; claims 6, 7, 9, 10, 16, 17, 19, and 20 as unpatentable over Littleton in view of U.S. Publication No. US 2001/004321 to Ausems et al.; claims 8, 11, 18, and 21 as unpatentable over Littleton in view of Ausems, and further in view of Kaufman; claim 12 as unpatentable over Littleton in view of U.S. Patent No. 6,721,787 to Hiscock and Ausems; claim 13 over Littleton in view of Hiscock and Ausems, and further in view of Novak; claim 14 as unpatentable over Littleton in view of Hiscock, Kaufman, and Ausems; claim 15 as unpatentable over Littleton in view of Hiscock, Kaufman and Ausems, and further in view of Novak; and claims 27-34 as unpatentable over Littleton in view of Ausems and U.S. Publication No. US 2002/0111156 to Roeder.

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In view of the claim amendments set forth above and the following remarks,
Applicant respectfully traverses the Examiner's rejections of the claims under 35 U.S.C.
§ 103(a).

I. Objection to Claim 35

The objection to claim 35 is addressed by the amendment of the claim as suggested by the Examiner. Accordingly, Applicant requests withdrawal of the objection to claim 35.

II. Amendment of Claims 16-18

Applicant amends the preamble of claims 16-18 to more properly reflect the nature of the claims.

III. Response to Rejections Under 35 U.S.C. § 103 (a)

Applicant respectfully traverses these rejections for the reasons set forth in detail below. To establish a prima facie case of obviousness, three basic criteria must be met. First, the prior art reference as modified must teach or suggest all the claim elements. (See M.P.E.P. § 2143.03 (8th ed. 2001)). Second, there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. (See M.P.E.P. § 2143 (8th ed. 2001)). Third a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." (M.P.E.P. § 2143.03 (8th ed. 2001)).

The Examiner rejected claims 1-3, 5, 22-26, and 35-37 as unpatentable over Kaufman in view of Littleton, and rejected claim 4 as unpatentable over Kaufman in view of Littleton, and further in view of Novak. Applicant begins with a discussion of claim 1.

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Claim 1, as amended, recites a combination including, for example, "a synchronization routine, wherein the synchronization routine is downloaded from a remote server if the synchronization routine is not present in the wireless telephone." Support for this amendment can be found throughout the application as originally filed, for example, at ¶ 0044 of the Specification.

None of the cited references provide a teaching of at least "a synchronization routine, wherein the synchronization routine is downloaded from a remote server if the synchronization routine is not present in the wireless telephone." Although Kaufman teaches a "wireless remote synchronization of data between PC and PDA" (Kaufman title) that provides for "simplified, discrete and automated synchronization of calendar and contact-related data between a personal computer and a remote personal digital assistant" (col. 1 lines 9-12), this does not constitute a teaching of "a synchronization routine, wherein the synchronization routine is downloaded from a remote server if the synchronization routine is not present in the wireless telephone." While Kaufman discloses a personal digital assistant containing a synchronization routine, Kaufman does not teach or suggest downloading a synchronization routine from a remote server if a routine is not already present in the personal digital assistant. Likewise, although Littleton teaches a "system and method for provisioning telephony services via a personal digital assistant" (Littleton title) that provides for "synchronization of information between a wireless portable device and a server" (¶ 0002), Littleton also fails to disclose downloading a synchronization routine from a remote server if a routine is not already present in the personal digital assistant. Therefore, neither Kaufman nor Littleton, taken alone or in any reasonable combination, teach a wireless telephone having "a

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synchronization routine, wherein the synchronization routine is downloaded from a remote server if the synchronization routine is not present in the wireless telephone" as recited in claim 1.

Since the cited references fail to teach all of the elements of claim 1, no prima facie case of obviousness has been made out. For at least the foregoing reasons, Applicant submits that claim 1 is allowable over Kaufman in view of Littleton and request withdrawal of the rejection of claim 1 under 35 U.S.C. § 103(a). Because claims 22 and 35 are independent claims with limitations similar to those of claim 1, Applicant further submits that claims 22 and 35 are also allowable over Kaufman in view of Littleton for at least the reasons given with respect to claim 1.

Moreover, Applicant submits that claims 2-5, 23-26, and 36-37 are allowable, not only for the reasons stated above with regard to their respective allowable base claims, but also for their own additional features that distinguish them from the cited references. Accordingly, Applicant requests withdrawal of the rejection of claims 2-5, 23-26, and 36-37 under 35 U.S.C. § 103(a) and the timely allowance of these pending claims.

The Examiner rejected claims 27 as unpatentable over Littleton in view of Ausems and further in view of Roeder.

The Examiner admitted that Littleton does not provide a teaching of "establishing a voice communication link between the wireless telephone and a second telephone" (OA pg. 10). Furthermore, although Ausems teaches a "personal digital assistant with wireless telephone" (Ausems title) that provides for "a personal digital assistant having expanded capabilities including wireless communication capabilities" (¶ 0002), Ausems fails to disclose "establishing a voice communication link between the wireless

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telephone and a second telephone; initiating a synchronization routine to transmit the data file from the wireless telephone to the computer over the wireless network; and receiving the data file by the computer,” as recited in claim 27. Instead, the Examiner relies on Roeder for a teaching of “establishing a voice communication link between the wireless telephone and a second telephone” (OA, pg. 10).

Even if all of the elements of claim 27 could be found in some combination of Littleton, Ausems, and Roeder (which Applicant disputes), a prima facie case of obviousness has not been established at least because the requisite motivation to combine the references is lacking. Determinations of obviousness must be supported by evidence on the record. See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by “substantial evidence”). The desire to combine references must be proved with “substantial evidence” that is a result of a “thorough and searching” factual inquiry. *In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52).

In this case, there is no “substantial evidence” in the record to support the attempted combination of Littleton, Ausems, and Roeder, and the requisite “clear and particular” motivation to support a prima facie case of obviousness is lacking. The Examiner does not show, by substantial evidence, that a skilled artisan having the cited references before him would have been motivated to combine those references in the manner resulting in Applicant’s claimed combination. The Examiner merely provides a

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description of how Roeder allegedly teaches certain features and fails to provide a proper motivation for combining that reference with Littleton and Ausems.

The Examiner alleged (OA, p. 10) that a skilled artisan would have combined Roeder's step of "establishing a voice communication link between the wireless telephone and a second telephone" with the steps of "initiating" and "receiving" disclosed by Littleton in view of Ausems because one of ordinary skill in the art would combine the steps "in order for the wireless PDA to synchronize its changes made to telephone service features that are stored in memory to the server computer database and follow up by making a telephone connection with the server computer to determine if changes has been made and make a voice call to a friend." These conclusory statements in the Office Action are not properly supported by facts on the record and do not evidence that a skilled artisan would have been motivated to combine the references in a manner resulting in Applicant's claimed combination. The Examiner fails to show that either of the relied-upon references suggests combining their teachings in a manner resulting in Applicant's claimed combination. The mere fact that Roeder mentions the step of "establishing a voice communication link between the wireless telephone and a second telephone" does not evidence the requisite motivation to combine.

Applicant calls attention to M.P.E.P. § 2143.01, which makes clear that

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (citations omitted).

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The Examiner does not show that the cited art "suggests the desirability of the" combination. No objective reason for combining the applied art to achieve the invention defined by claim 27 has been established.

For at least the reasons advanced above, the requisite motivation to combine is lacking. Moreover, the Examiner has not shown, by substantial evidence, that there is a reasonable expectation of success in combining Littleton, Ausems, and Roeder.

For at least the reason that the required motivation to combine the applied references is lacking, prima facie obviousness has not been established with respect to claim 27. For at least the foregoing reasons, Applicant submits that claim 27 is allowable over Littleton in view of Ausems and further in view of Roeder and requests withdrawal of the rejection of claim 27 under 35 U.S.C. § 103(a). Because claims 6, 9, 16, 19, and 31 are independent claims with limitations similar to those of claim 27, Applicant further submits that claims 6, 9, 16, 19, and 31 are also allowable over Littleton in view of Ausems and further in view of Roeder, for at least the reasons given with respect to claim 27.

Moreover, Applicant submits that dependent claims 7, 8, 10, 11, 17, 18, 20, 21, 28-30, and 32-34 are allowable not only for the reasons stated above with regard to their respective allowable base claims, but also for their own additional features that distinguish them from the cited references. Accordingly, Applicant requests withdrawal of the rejection of claims 7, 8, 10, 11, 17, 18, 20, 21, 28-30, and 32-34 under 35 U.S.C. § 103(a) and the timely allowance of these pending claims.

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IV. Conclusion

Applicant respectfully submits that this Amendment places claims 1-11 and 16-37 in condition for allowance.

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to deposit account 07-2347.

Respectfully submitted,

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Dated: October 26, 2004

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